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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/881,938 | 06/14/2001 | Shoichi Nagatomo | 01347/LH | 7688 |

1933 7590 05/19/2004

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EXAMINER

GREENE, DANIEL L

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| ART UNIT | PAPER NUMBER |
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3621

DATE MAILED: 05/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/881,938

Applicant(s)

NAGATOMO ET AL.

Examiner

Daniel L. Greene

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 5 recites the limitation " the high-definition image" in first limitation, line 25.

There is insufficient antecedent basis for this limitation in the claim. The preamble discloses "high-definition" data, not high-definition image" data.

- 3.

Allowable Subject Matter

4. Claim 28 would be allowable if rewritten to include all of the limitations of the base claim and any intervening claims.
- 5.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 1 - 27 and 29-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sato et al. U.S. Patent 5,475,656A [Sato], and further in view of Guthery U.S. Patent 6,567,915B1 [Guthery]**

3.

4. As per Claims 1 and 11:

The recitation "A data managing apparatus, and or A data managing method", has not been given patentable weight because it has been held that a preamble is denied the effect of a limitation where the claim is drawn to a method, a system, an apparatus, etc. and the portion of the claim following the preamble is a self-contained description of the method or the system, etc., not depending for completeness upon the introductory clause. *Kropa v. Robie*, 88 USPQ 478 (CCPA 1951)

5.

Sato discloses a disk-in-card with a semiconductor memory area "A" as shown in Fig. 36. Sato further discloses that the semiconductor memory on the card can provide the security to use the card as a cash card and for information requiring secrecy. Col. 27, lines 15-25. It would have been obvious to one having ordinary skill in the art at the time the invention was made that the semiconductor memory can be utilized to control the access to the disk and that it is programmable because as stated in the reference, it utilizes "a random number code and the like..." Col. 27, lines 19-20. Guthery teaches that it is known in the art to provide a connecting means for connecting the recording medium via a network to a server system on the Internet. Col. 4, lines 30-45.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the semiconductor memory of Sato with the connecting means for connecting the recording medium via a network to a server system on the

Internet, of Guthery, in order to reprogram the semiconductor memory to provide control and access to the disk as required.

storage control means for storing changing data, related to the fixed data and read from said server system, in said first storage area in the first access method; Col. 27, lines 15-30. and

reading means for reading the fixed data corresponding to the changing data in the second access method from said second storage area. Fig. 19.

As per claims 1 -5, and 12-15:

The recitation " A data managing apparatus, and or A data managing method", has not been given patentable weight because it has been held that a preamble is denied the effect of a limitation where the claim is drawn to a method, a system, an apparatus, etc. and the portion of the claim following the preamble is a self-contained description of the method or the system, etc., not depending for completeness upon the introductory clause. *Kropa v. Robie*, 88 USPQ 478 (CCPA 1951)

References Sato and Guthery does not expressly show that the data stored and used in the semiconductor memory and the disk is, " changing and fixed", retrieval and contents", " index and detailed", "compressed and uncompressed high-definition" and "thumbnail and high-definition".

However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The storage control means and the reading means steps would be performed the same regardless of the

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data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to store the, "changing and or retrieval and or index and or compressed and or thumbnail" data and read the "fixed, and or contents, and or detailed and or compressed and or high-definition" data, as per Claim 1 rejection, because such data does not functionally relate to the steps in the apparatus claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

As per claim 6:

Sato further discloses:

said storage control means further stores security information in the recording medium in said first storage area. Col. 27, lines 15-30.

As per claim 7:

Sato discloses the claimed invention except for the wherein the security information in the recording medium comprises a personal authentication code and information for inhibiting copying data stored in the recording medium. However Sato, as per Col. 27, lines 15-30, does teach about the use of a semiconductor memory to

ensure security and utilizing the programmable attributes of the semiconductor memory to expand the capabilities of the disk-in-card to be able to be used as a cash card.

Guthery teaches that it is known in the art to provide wherein the security information in the recording medium comprises a personal authentication code and information for inhibiting copying data stored in the recording medium. Fig. 3, and Col. 8, lines 65-67 - Col. 9, lines 1-67.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide for the security section of Sato, the wherein the security information in the recording medium comprises a personal authentication code and information for inhibiting copying data stored in the recording medium of Guthery, in order to restrict the unauthorized use of the disk portion of the card.

As per claim 8:

Sato further discloses:

wherein said storage control means stores security information for the contents data in said first storage area. Col. 27, lines 15-30.

As per claim 9:

Sato does not expressly show wherein the security information for the contents data comprises information for inhibiting copying the contents stored in the recording medium. However, Sato does teach about utilizing the semiconductor memory to control actions and access to the information on the disk. Col. 27, lines 25-30.

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Guthery teaches about programming an IC/ semiconductor memory to provide requirements to be met or actions/transaction are not authorized and prevented.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to provide security information for inhibiting copying the contents stored in the recording medium.

As per claims 10 and 16:

Sato further discloses:

wherein said first storage area comprises a static storage area and said second storage area comprises a dynamic storage area. Col. 27, lines 15-30.

6. As per claims 17, 19, 26 and 30:

The recitation, "A data reading apparatus, and An information managing system", has not been given patentable weight because it has been held that a preamble is denied the effect of a limitation where the claim is drawn to a method, a system, an apparatus, etc. and the portion of the claim following the preamble is a self-contained description of the method or the system, etc., not depending for completeness upon the introductory clause. *Kropa v. Robie*, 88 USPQ 478 (CCPA 1951)

Sato and Guthery show reading, inhibiting, and permitting actions concerning data. Sato and Guthery do not expressly stipulate that the data is "free and pay contents.

However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The reading and inhibiting steps would be performed the same regardless of the data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to read the free and pay contents, inhibit said reading means from reading the pay contents data and permit said reading means to read the pay contents because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

As per claim 18:

Sato discloses a disk-in-card with a semiconductor memory area "A" as shown in Fig. 36. Sato further discloses that the semiconductor memory on the card can provide the security to use the card as a cash card and for information requiring secrecy. Col. 27, lines 15-25. It would have been obvious to one having ordinary skill in the art at the time the invention was made that the semiconductor memory can be utilized to control the access to the disk and that it is programmable because as stated in the reference, it utilizes "a random number code and the like..." Col. 27, lines 19-20. Guthery teaches that it is known in the art to provide a connecting means for connecting the recording medium via a network to a server system on the Internet. Col. 4, lines 30-45.

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It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the semiconductor memory of Sato with the connecting means for connecting the recording medium via a network to a server system on the Internet, of Guthery, in order to reprogram the semiconductor memory to provide control and access to the disk as required.

As per claim 20:

Sato further discloses:

wherein said inhibiting means is provided in said storage medium. Col. 27, Lines 15-30.

As per claim 21:

Sato further discloses:

wherein said inhibiting means is provided in said reader. Col. 27, lines 15-30.

As per claim 22:

wherein the recording medium comprises switching means for switching the free contents data to the pay contents data in accordance with the predetermined procedures. Col. 27, lines 15-30.

As per claim 23:

Sato discloses a disk-in-card with a semiconductor memory area "A" as shown in Fig. 36. Sato further discloses that the semiconductor memory on the card can provide the security to use the card as a cash card and for information requiring secrecy. Col. 27, lines 15-25. It would have been obvious to one having ordinary skill in the art at the time the invention was made that the semiconductor memory can be utilized to control the access to the disk and that it is programmable because as stated in the reference, it utilizes " a random number code and the like..." Col. 27, lines 19-20. Guthery teaches that it is known in the art to provide a connecting means for connecting the recording medium via a network to a server system on the Internet. Col. 4, lines 30-45.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the semiconductor memory of Sato with the connecting means for connecting the recording medium via a network to a server system on the Internet, of Guthery, in order to reprogram the semiconductor memory to provide control and access to the disk as required.

As per claim 24:

Sato further discloses:

wherein the recording medium further comprises an electronic storage area.

Fig. 4, 140.

As per claim 25:

Sato further discloses:

wherein said electronic storage area comprises said permitting means.

Fig. 36, semiconductor memory area "A".

As per claim 27:

Sato further discloses:

wherein said inhibiting means is provided in said server system. Col. 7,

Lines 15-30.

As per claim 29:

Sato further discloses:

wherein said procedures comprise inputting authentication data from said reader to said server system. Col. 7, lines 15-30.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel L. Greene whose telephone number is 703-306-5539. The examiner can normally be reached on M-Thur. 8am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell can be reached on 703-305-9768. The fax phone

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number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

5/11/04

DLG



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